

Appl. No. 09/714,783
Amdt. dated November 14, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

REMARKS/ARGUMENTS

STATUS OF THE APPLICATION

Claims 1-19, 24, and 32-38 are pending in this application.

Claims 1, 3, 4, 6, 7, 9, 16, 18, 24, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamise (Unexamined Japanese Patent JP 10246041A--Machine Assisted Translation) (hereinafter "Kamise"). Claims 2, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamise in view of Takasaki et al. (Japanese Patent JP403129990A--Only English Abstract) (hereinafter "Takasaki"). Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamise in view of McAbian (U.S. Patent No. 5,845,261). Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamise in view of Kanevsky et al. (U.S. Patent No. 6,334,109) (hereinafter "Kanevsky"). Claims 10 and 33 are rejected under 35 U.S.C 103(a) as being unpatentable over Kamise in view of Motomiya et al. (U.S. Patent No. 6,189,783) (hereinafter "Motomiya"). Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamise in view of Coffin et al. (U.S. Patent No. 5,991,429) (hereinafter "Coffin"). Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamise in view of Bellagarda et al. (U.S. Patent No. 5,502,774) (hereinafter "Bellagarda"). Claims 15, 19, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamise in view of Pare, Jr. et al. (U.S. Patent No. 5,764,789) (hereinafter "Pare Jr."). Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamise in view of Pare, Jr. et al. Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamise in view of Pare, Jr. et al., and further in view of Markus et al. (U.S. Patent No. 6,490,601) (hereinafter "Markus").

Applicants have amended claims 1, 16, and 24. Applicants submit that no new subject matter has been introduced by the amendments. Claims 1-19, 24, and 32-38 remain pending in this application after filing of this amendment.

Appl. No. 09/714,785
Amdt. dated November 14, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

THE CLAIMS

Claim 35

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamise in view of Pare, Jr. et al. The Office Action acknowledges that Kamise does not teach the use of communication interfaces and the use of additional information distinct from information gathered by the system's sensors and input devices. (See Final Office Action: pg. 15, 1st paragraph). The Office Action goes on to state that the use of additional information distinct from information gathered by the system's sensors and input devices is taught by Pare Jr. The Office Action then concludes that claim 35 is unpatentable over Kamise in view of Pare Jr.

Applicants respectfully traverse the rejection and submit that claim 35 is patentable for at least the following reasons:

(1) Pare Jr. is non-analogous prior art

Applicants submit that Pare Jr. is non-analogous prior art and thus cannot be relied on as a 35 U.S.C. 103 reference.

MPEP 2141.01(a) states that in order to rely on a reference under 35 U.S.C. 103, it must be analogous prior art. The determination of whether a reference is analogous is twofold. "In order to rely on a reference as a basis for rejection of an applicant's invention, [a] the reference must either be in the field of the applicant's endeavor or, [b] if not, then be reasonably pertinent to the particular problem with which the invention is concerned." MPEP 2141.01(a) citing In re Oetiker, 977 F.2d 1443, and other cases.

[a] Pare Jr. is not in the field of the applicant's endeavor

Pare Jr. relates to a tokenless biometric ATM access system that provides a method and system for tokenless access to financial accounts provided by various institutions. Customer can access their financial accounts using automated terminals without having to use any portable man-made memory devices, such as smartcards, or swipe cards. (Pare Jr.: col 3 lines 51-56). Accordingly, Pare Jr., relates to the field of systems for accessing financial services and more particularly to techniques that reduce fraudulent practices (by not using physical devices such as cards) in the use of such systems in the financial industry. (See Pare Jr.

Appl. No. 09/714,785
Amdt. dated November 14, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

Background section). Pare Jr. teaches techniques that use biometrics information instead of a physical token (e.g., a smartcard, ATM card, debit card) to allow a user to access financial account information. A customer registers for a financial account using a PIN and one or more biometric samples. The customer can then access the financial account using an ATM by entering the customer's PIN and a biometric sample. The PIN and biometric sample are then used to authorize the customer and allow access to the financial account. (See Pare Jr. Summary).

In contrast, the present invention relates to a system for gathering information about visitors. The apparatus recited in claim 35 comprises input devices and sensors that capture information about a visitor. The information provided by the visitor using the input devices and the information captured by the devices is then used to find additional information about the visitor that is distinct from the user provided information. The additional information is then communicated to a person to be visited by the visitor.

The present invention thus relates to a system for gathering information about visitors which is substantially different from Pare Jr. which relates to the field of systems for accessing financial services and more particularly to techniques for reducing fraudulent practices in the use of such systems in the financial industry. The present invention is not concerned about preventing fraud. Accordingly, Applicants submit that Pare Jr. is not in the field of the applicant's endeavor.

[b] Pare Jr. is not reasonably pertinent to the particular problem with which the invention is concerned

As stated above, the present invention relates to a system for gathering information about visitors. The apparatus recited in claim 35 comprises input devices and sensors that capture information about a visitor. The information provided by the visitor using the input devices and the information captured by the devices is then used to find additional information about the visitor. The additional information is then communicated to a person to be visited by the visitor.

Appl. No. 09/714,785
Amdt. dated November 14, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

Unlike Pare Jr., the present invention is not concerned about providing access to financial accounts. Further, unlike Pare Jr., the present invention is not concerned about reducing fraudulent practices associated with physical tokens such as smartcard, debit cards, etc. Accordingly, the present invention and Pare Jr. relate to completely different fields and have different purposes.

Further, as described above, the problems that the present invention and Pare Jr. attempt to resolve are completely different. Accordingly, based upon the matter with which the present invention deals, Pare Jr. would not have commended itself to the attention of inventors of the present invention as claimed in claim 35.

Based on the foregoing, Applicants submit that Pare Jr. is non-analogous prior art and thus it is inappropriate to rely on Pare Jr. as a 35 U.S.C. 103 reference. Thus, the combination of Kamise and Pare Jr. is believed to be improper.

(2) The combination of Kamise and Pare Jr. is improper

A basic criteria for establishing a prima facie case of obviousness is that there must be some suggestion or motivation, whether in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. (See MPEP 2143). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (See MPEP 2143.01). Absent such a showing in the prior art, the examiner has impermissibly used "hindsight" by using the applicant's teaching as a blueprint to hunt through the prior art for the claimed elements and combine them as claimed. In re Zurko, 111F.3d 887; In re Vaeck, 947 F.2d 488. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (See MPEP 2143.01 citing In re Mills, 916 F.2d 680).

Appl. No. 09/714,785
Amtd. dated November 14, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

(a) There is lack of suggestion to combine Kamise and Pare Jr.

Applicants submit that there is no explicit or implicit motivation in the references themselves to combine the references. Kamise teaches an unmanned reception system that provides various means for capturing a visitor's image and business card information, means for communicating with a receptionist, and a card dispensing means for dispensing a card for the visitor. (See Kamise: paragraphs [0005] through [0017]). The information about the visitor is stored in a visitor database (See Kamise: paragraph [0018]). The visitor can use the card to gain entry through various gates. Pare Jr. on the other hand, relates to the field of systems for accessing financial services and more particularly to techniques for reducing fraudulent practices in the use of such systems in the financial industry.

There is no suggestion or need in Kamise, either explicit or implicit, to use techniques for providing access to financial accounts or for providing techniques to reduce fraud associated with the use of physical tokens/devices such as cards. Likewise, there is no suggestion in Pare Jr., either explicit or implicit, to use techniques for receiving visitors and handing out card to visitors. In fact, Applicants submit that the teachings in Kamise and Pare Jr. teach away from and are contrary to each other. While Kamise teaches an unmanned reception system that issues cards to visitors, Pare Jr. on the other hand teaches away from the use of cards. Accordingly, one of ordinary skill in the art would not be motivated to combine Kamise and Pare Jr.

Based upon the above, Applicants submit that there is no motivation or suggestion to combine Kamise and Pare Jr.

(b) Proposed modification of Kamise and Pare Jr. renders the inventions of Kamise and Pare Jr. unsatisfactory for their intended purpose

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (See MPEP 2143.01 citing In re Gordon, 733 F.2d 900).

As described above, Kamise describes an unmanned reception system that captures and stores visitor information and dispenses a card that the visitor can use to enter

Appl. No. 09/714,785

PATENT

Amdt. dated November 14, 2003

Amendment under 37 CFR 1.116 Expedited Procedure

Examining Group

through various gates. Accordingly, the dispensing and use of a card by the visitor is a central feature of Kamise. Pare Jr., on the other hand, teaches techniques for accessing financial information using an ATM without using physical devices such as cards. Accordingly, the non-use of a card is a central feature of Pare Jr.

If the references were combined, then the proposed combination of Kamise and Pare Jr. would result in a system that either (i) provides for use of cards as in Kamise, which is contrary to the teachings of Pare Jr. and destroys its intended function; or (ii) provides for no use of cards as in Pare Jr., which is contrary to the teachings of Kamise and destroys its intended purpose. Thus, any combination of Kamise and Pare Jr. would destroy the intended purpose of either Kamise or Pare Jr.

Applicants thus respectfully submit that combination or modification of Kamise and Pare Jr., as proposed by the Examiner, is improper as it destroys the intended functions of the references.

(c) The proposed modification of Kamise and Pare Jr. changes the principle of operation of Kamise and Pare Jr.

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (See MPEP 2143.01 citing In re Ratti, 270 F.2d 810).

As described above, Kamise describes an unmanned reception system that captures and stores visitor information and dispenses a card that the visitor can use to enter through various gates. Pare Jr., on the other hand, teaches techniques for accessing financial information using an ATM without using physical devices such as cards. Accordingly, the basic principle of operation of Pare Jr. is that no physical device such as a card is used.

If the references were combined as suggested by the Examiner, the proposed combination of Kamise and Pare Jr. would result in a system that either (i) provides for the use of cards as in Kamise--this is contrary to the principle of operation of Pare Jr.; or (ii) provides for no use of cards as in Paper Jr.--which is contrary to the principle of operation of Kamise and

Appl. No. 09/714,785
Amdt. dated November 14, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

destroys its intended purpose. Thus, any combination of Kamise and Pare Jr. would change the principle of operation of either Kamise or Pare Jr.

Applicants thus respectfully submit that combination or modification of Kamise and Pare Jr., as proposed by the Examiner, is improper as it changes the principle of operation of the references.

Based upon the foregoing, Applicants submit that the combination of Kamise and Pare Jr. is improper. Applicants submit that the examiner has impermissibly used "hindsight" based upon the teachings from the Applicant's invention to hunt through the prior art for the claimed elements and combine them as claimed. Consequently, Applicants submit that claim 35 is patentable.

(3) Even if Kamise and Pare Jr. are combined, the resultant combination fails to teach or suggest the invention recited in claim 35

Applicants submit that, even if, *assuming arguendo*, one of ordinary skill in the art were to combine Kamise and Pare Jr. as suggested by the Examiner, the resultant combination would not have led to Applicants' invention as recited in claim 35.

The Examiner has pointed to col. 41 lines 31-33 of Pare Jr. as teaching the "additional information . . ." feature of claim 35. The section pointed to by the Examiner merely discloses an Individual Biometric Database (IBD) with records that store personal information for customers that is used for identification as well as authentication. This is quite different from the "additional information" recited in claim 35 that is determined based upon information provided by the visitor using an input device or information captured about the visitor by a sensor. Pare Jr. does not teach the determining of additional information as recited in claim 35. In Pare Jr., the information that is already stored in the IBD is used for identification of the user and thus no determining of the information has to be done. Accordingly, Applicants submit that the feature of determining additional information as recited in claim 35 is not taught or suggested by Pare Jr.

Appl. No. 09/714,785
Amdt. dated November 14, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

Further, as acknowledged by the Examiner, such a feature is also not taught or suggested by Kamise (See Final Office Action: pg. 15, 1st paragraph). Accordingly, even if, *assuming arguendo*, the references were combined as indicated by the Examiner, the resultant combine would not disclose such a feature. Applicants thus submit the claim 35 is patentable.

Claims 36-38

Applicants further submit that claims 36-38 which depend from claim 35, should also be allowed for at least a similar rationale as discussed for allowing claim 35, and others.

Claims 1-19, 24, and 32-34

Applicants have amended independent claims 1, 16, and 24 to include the "additional information distinct from . . ." feature of claim 35. Applicants thus respectfully submit that independent claims 1, 16, and 24 are allowable for at least a similar rationale as discussed for allowing claim 35, and others. Applicants further submit that claims 2-34 and 17-19 which depend from claims 1 and 16 respectively, are also allowed for at least a similar rationale as discussed for allowing claims 1 and 16, and others.

Appl. No. 09/714,785
Amdt. dated November 14, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

S. B. Kotwal

Sujit B. Kotwal
Reg. No. 43,336

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
SBK:km
60081440 v1